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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,260	08/14/2006	Luca Doglioni Majer	MGT-0634-E50	2431
63704 7590 03/30/2010 HESS PATENT LAW FIRM, P.C. 9 MIRAMAR LANE STAMFORD, CT 06902				
EXAMINER WILLIAMS, LEA				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/585,260

**Applicant(s)**

DOGLIONI MAJER, LUCA

**Examiner**

LELA S. WILLIAMS

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/12/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-14 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date 6/30/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 7-14 and 18-20 in the reply filed on January 12, 2010 is acknowledged.
2. Claims 1-6 and 15-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 12, 2010.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. **Claims 10, 13, 14, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claims 10, 13, & 14** recites the limitation "said outlet lid portion" and "said lid portion". There is insufficient antecedent basis for this limitation in the claim. Claim 7 states "a dispensing wall lid portion" and applicant is advised to keep claim language consistent.

**Regarding claim 19**, the claim states a "filter element is spaced from a bottom wall" it is unclear to what this means. The term "spaced" is a relative term which renders the claim indefinite. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

**Regarding claim 20**, the claim states "wherein said outlet lid portion is open outwardly". It is unclear if this means it is opened by an outside force or if when it is open, the direction to which it opens goes outside the capsule. In effort to further prosecution, the meaning is taken to be opened by an outside force.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**6. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bardin et al. EP 1243210.**

**Regarding claims 7-9**, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and lid portion (figure 6, item 23) which opens to discharge the liquid. The lid portion is said to open inward as a mechanical reaction force is applied from the outside, inherently varying the area of dispensing area while it is opening. Given the disclosure of the folding means "is adapted to cause the opening member to fold upon action of said reaction force", meaning the folding means is acting as a joint holding the lid portion and wall portion so that the lid can swing, it is inherently a hinge [0007, 0009, 0017] and would inherently function to impart an oscillating movement to the wall during the dispensing step.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**10. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210.**

**Regarding claim 10**, as discussed in paragraph 6 above, Bardin comprises a hinge means attached to the dispensing wall of the capsule. The reference discloses that once the water stops entering the capsule and the plunger separates, the capsule substantially or partially recovers to its initial dimension (col. 9, line 30-35). Given this disclosure one of ordinary skill would reasonably expect and find it obvious that the lid portion would also close at least partially, because the pressure is no longer applied and there is no outside force acting on it.

**Regarding claim 11**, Bardin is applied to claim 7 as discussed in paragraph 6 above. The reference discloses a capsule which is able to withstand the pressure of an extraction system [0021]; however the reference does not disclose the rigidity of the capsules as measured by a punch. Given Bardin's teaching of constructing a capsule with "pressure resistant but elastically deformable material" it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with enough rigidity, including that presently claimed, to withstand the pressure of the extraction system, which it is to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a prima facie obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one of ordinary skill in the art to use a suitable material for the use of an extraction system.

**Regarding claim 12**, Bardin discloses a beverage capsule for the preparation of a beverage obtained by supplying water within the capsule (abstract) having a dispensing wall and lid portion (figure 6, item 23) which opens to discharge the liquid. The reference discloses a

capsule which is able to withstand the pressure of an extraction system [0021]; however the reference does not disclose the rigidity of the capsules as measured by a punch. Given Bardin's teaching of constructing a capsule with "pressure resistant but elastically deformable material" it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule with enough rigidity, including that presently claimed, to withstand the pressure of the extraction system, which it is to be utilized. Furthermore, the selection of a known material based on its suitability for its intended use supports a prima facie obviousness as determined in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) and *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (see MPEP 2144.07). Therefore, it would have been obvious to one of ordinary skill in the art to use a suitable material for the use of an extraction system.

**Regarding claims 13 and 14**, Bardin is applied as discussed above. The reference discloses a capsule which has an area capable of being opened to allow fluid to pass [0009]. Although the reference does not disclose the thickness of the surrounding wall, it would have been obvious to one of ordinary skill in the art at the time of the invention to construct a capsule wherein the thickness of the opening portion is greater than its surrounding walls, to withstand the force which is applied to it and not break off in the process. The reference is also silent concerning the angle of inclination; however figure 5 of Bardin shows a capsule which does not have a flat bottom, thereby resulting in an angle of inclination. It is noted that said angle is not expressly disclosed, however given that applicant has not demonstrated the criticality of said angle and any changes in shape are considered "a matter of choice which a person of ordinary

skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.” *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (see MPEP 2144.04 IV.B). Therefore, it would have been obvious to one of ordinary skill in the art to determine a suitable shape.

**11. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardin et al. EP 1243210 in view of Fond U.S Pat. No. 5,242,702**

**Regarding claims 18-20**, Bardin discloses a capsule for preparing a beverage from food substance within said capsule (abstract) having a dispensing wall and lid portion which opens inward as a mechanical reaction force is applied from the outside, to discharge the liquid, as applied to claims 7-9 in paragraph 6 above. Bardin, however does not disclose a filter element. Fond discloses a beverage capsule “used for the extraction of ground coffee...comprising a lower face on which a filter is placed” (col.2, lines 5-10). Given that Bardin teaches the capsule to contain a “dry food substance” [0001] to make a coffee beverage, it is obvious the dry substance would be coffee grounds, and thus obvious to use a coffee filter as taught by Fond. One of ordinary skill would have been motivated to use a filter when using coffee ground to ensure that none of the grounds get into the beverage.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 02/076270 discloses a capsule for preparing a beverage and is cumulative to the rejections of record.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to LELA S. WILLIAMS whose telephone number is (571)270-1126. The examiner can normally be reached on Monday to Thursday from 7:30am-5pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. S. W. /  
Examiner, Art Unit 1794

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1794